



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,454	01/31/2001	William W. Cimino	5116.01	8022

23552 7590 07/09/2003

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

LINDSEY, RODNEY M

ART UNIT	PAPER NUMBER
----------	--------------

3765

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,454

Applicant(s)

CIMINO, WILLIAM W.

Examiner

Rodney M. Lindsey

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 May 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the claims of Group II require the making and fabrication of an "ultrasonic applicator" and thus a process for forming an ordinary scalpel would not fall within the scope of such claims. This is not found persuasive because the mere use of the term "ultrasonic applicator" in no way precludes the scalpel of Rhandhawa, noting that no structural details of the ultrasonic applicator are being specified, only its material composition and its intended use, e.g. as a blade or as a lipoplasty device. Further note that the ultrasonic applicator on line 1 of claim 16 is seen to denote a final product while the ultrasonic applicators on lines 3 and 4 of claim 16 represent intermediate products absent the coating of the final product. Thus the method of claim 16 is set forth by lines 3-5 thereof which steps can clearly be used to form the device of Rhandhawa.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 16-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 6.

3. This application contains claims 16-23 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 22, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the details of the ultrasonic applicator as per proposed Figure 1.

5. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Specification

6. The disclosure is objected to because of the following informalities: On page 6, line 10 "Figure 1" is not understood.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6, 7, 10, 11, 14, 15, 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 8, 12 and 24 the surface coating of aluminum oxide is set at a thickness of between about 0.0001 and 0.0003 inch. In contrast dependent claims 6, 10, 14 and 29 set the thickness as being between about 0.0003 and 0.0005 inch. As claims 6, 10, 14 and 29 include the limitations

Art Unit: 3765

claims 1, 8, 12 and 24 they are therefore confusing as to the possible thickness of the aluminum oxide coating. Clearly the coating cannot be dually thick and thin as required by claims 6, 10, 14 and 29.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-15 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hood '143 in view of Rhandhawa.

Hood '143 discloses an ultrasonic applicator or knife for use by surgeons formed of a base portion of aluminum alloy (see column 7, line 49) and of a surface coating of ceramic material or aluminum oxide (see column 7, line 53). With respect to claims 1, 8, 12 and 24 Hood '143 does not teach that the aluminum oxide coating be of a thickness of between 0.0001 and 0.0003 inch. Rhandhawa teaches old and well known the use of ceramic material coatings of a thickness of from 1 to 10 microns on medical tools (see claim 3). To modify the applicator of Hood '143

Art Unit: 3765

such that the thickness of the aluminum oxide coat is between 0.0001 and 0.0003 inch would have been obvious since one of ordinary skill in the art of coated medical devices at the time of the invention would readily have recognized such coating thickness as being within an effective coating thickness range for providing wear resistance in the manner of the coatings of Rhandhawa. With respect to claims 2 and 25 note the blade 26 of Hood '143. With respect to claims 3 and 26 Hood '143 does not teach a lipoplasty device. However, Rhandhawa teaches that it is old to provide protective coatings to other medical tools (see column 1, line 30). To modify Hood '143 by providing the aluminum oxide coating on other medical tools such as a lipoplasty device would have been obvious in view of Rhandhawa since one of ordinary skill in the art at the time of the invention would readily have recognized the coating as providing a like protection to other medical tools. With respect to claims 4, 8, 12 and 27 the specific type of aluminum alloy employed by Hood '143 would have been considered an obvious matter of choice and design to one of ordinary skill in the art at the time of the invention since all that would have been required is that the particular aluminum alloy be usable under ultrasonic conditions and be compatible with the coating. With respect to claims 6, 10, 14 and 29 Rhandhawa teaches old the use of a variety of color coatings. It would have been obvious for one of ordinary skill in the art at the time of the invention to provide the coating of Hood '143 with the colorant of Rhandhawa to achieve the advantage of effecting a distinguishing color to the medical tool. With respect to claim 31 the manner in which the coating is performed is not seen to set forth a method of use step not found in Hood '143.

Response to Arguments

12. Applicant's arguments filed May 22, 2003 have been fully considered but they are not persuasive. Contrary to applicant's remarks the prior art as represented by Hood clearly provides basis for an applicator of an aluminum alloy base with an aluminum oxide coating. Further, the prior art as represented by Rhandhawa teaches a coating thickness in the range claimed. That applicant has discovered an advantage of a particular coating thickness is of no moment in light of the teaching of the prior art that such a thickness is old in the art. It is not required that coating of Hood be of a thickness as suggested by the teachings of Rhandhawa for the reasoning advanced in applicant's specification. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). All that is required is that the prior art show that such a thickness is well known, and for whatever reason. Applicant's claimed coating thickness is maintained to already be within the body of the prior art. Further it is seen that one concerned with ultrasonic medical devices would not preclude what others had done in medical devices in general. In response to applicant's argument that Rhandhawa is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rhandhawa is in the field of applicant's endeavor as it is a medical device used in surgery. The rejection of claims 1-15 and 24-31, ably set forth above, is deemed proper in all respects.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Lindsey whose telephone number is (703) 305-7818. The examiner can normally be reached on M-F (8:30-5:00).

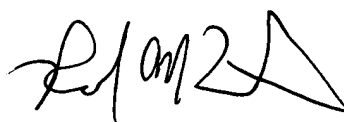
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

Application/Control Number: 09/773,454

Art Unit: 3765

Page 8

A handwritten signature in black ink, appearing to read 'R. M. Lindsey', with a stylized flourish at the end.

Rodney M. Lindsey
Primary Examiner
Art Unit 3765

rml

July 8, 2003